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No. 95-475

IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1995

SOUTHWALL TECHNOLOGIES, INC.,

Petitioner,

v.

CARDINAL IG COMPANY,

Respondent.

ON PETITION FOR WRIT OF CERTIORARI TO
THE UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

RESPONDENT'S BRIEF IN OPPOSITION

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QUESTION PRESENTED

In interpreting a patent claim, is a Court limited to consideration of only the history of that particular claim and its predecessor(s)?

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RESPONDENT'S BRIEF IN OPPOSITION

Respondent, Cardinal IG Company, requests that the Court deny the petition for a writ of *certiorari* to review the judgment of the United States Court of Appeals for the Federal Circuit entered in this case on May 10, 1995.

OPINIONS BELOW

Southwall Technologies, Inc. ("Southwall") initiated a civil action for patent infringement against Cardinal IG Company ("Cardinal") in the Northern District of Cali-

fornia. The District Court action was disposed of in 1994 by the granting of Cardinal's motion for summary judgment of non-infringement. *Southwall Technologies, Inc. v. Cardinal IG Co.*, 1994 U.S. Dist. LEXIS 3198 (N.D. Cal.—February 28, 1994).

Southwall appealed the District Court's judgment to the United States Court of Appeals for the Federal Circuit, which the Federal Circuit affirmed in an opinion dated May 10, 1995. *Southwall Technologies, Inc. v. Cardinal IG Co.*, 54 F.3d 1570 (Fed. Cir. 1995). In a subsequent opinion, the Federal Circuit denied Southwall's request for rehearing and suggestion for rehearing *en banc*. *Southwall Technologies, Inc. v. Cardinal IG Co.*, 1995 U.S. App. LEXIS 16624 (Fed. Cir.—June 21, 1995).

SUMMARY OF THE ARGUMENT

Southwall argues that the Federal Circuit erred when it failed to trace the history of each of the claims asserted to be infringed through the Patent Office history of the patent and that, as a result, the Federal Circuit improperly incorporated a limitation from a narrow claim into a broader claim. More specifically, Southwall argues that the Federal Circuit should have, but did not, draw a distinction between the phrase "sputter-deposited dielectric" and the phrase "sputter-deposited inorganic metal oxide, compound, or salt dielectric." According to Southwall, "dielectric" is broader than "inorganic metal oxide, compound, or salt dielectric" and claims containing the different phrases should be interpreted differently.

In fact, the term interpreted by the Federal Circuit and the District Court, as a matter of law, was "sputter-deposited." Because all of the asserted claims use the

term "sputter-deposited," the Federal Circuit determined that, to that extent, the asserted claims should be interpreted the same, both with respect to each other and with respect to any other claim using "sputter-deposited." Further, the Federal Circuit observed that because Southwall had failed to place any evidence in the record on the meaning of "sputter-deposited," no factual dispute had been presented for resolution by the District Court.

It is established law (with which Southwall agrees) that the same words appearing in different claims in the same patent must mean the same thing. Thus, there was no error made by the Federal Circuit when it relied on statements made in the Patent Office history of the Southwall patent about the meaning of "sputter-deposited" even though the claim being considered at the time the statement was made was not the same as the claims asserted against Cardinal. Southwall, in an attempt to create an issue for review by this Court, has mischaracterized what the courts below have done. What was done by the Federal Circuit in interpreting the claims of the Southwall patent is not in conflict with any precedent of this Court. Thus, Southwall's Petition for a Writ of *Certiorari* should be denied.

REASONS FOR DENYING THE WRIT

I.

THE QUESTION PRESENTED BY SOUTHWALL MISCHARACTERIZES THE FEDERAL CIRCUIT'S OPINION.

The crux of Southwall's argument is that the Federal Circuit erroneously interpreted the asserted claims of a patent by interpreting a broad term in these claims based on assertions made to the Patent Office with respect to

a different term in other more narrow claims.[1] Southwall further argues that the narrow claims were unrelated to the broad claims in issue.

The issue, therefore, according to Southwall, is whether a court in interpreting a claim must, as a matter of law, trace the Patent Office history of each patent claim to assure that its interpretation is affected only by the portion of the Patent Office history which pertains to that claim and not by the Patent Office history which pertains to other more narrow language used in other claims. Southwall's arguments are flawed because the term interpreted by the Courts below is "sputter-deposited." The asserted claims, which use the term "sputter-deposited," must be interpreted, as did the Federal

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[1] In its petition, Southwall states:

"In the present case, the asserted patent claim contained the phrase 'sputter-deposited dielectric.' Another unrelated patent claim, which had been rejected during the course of the patent's examination, contained the different and narrower phrase 'sputter-deposited inorganic metal oxide, compound or salt dielectric.' The latter claim expression describes a 'species' of the former claim describing a 'genus' which is dielectrics. These two claim phrases clearly differ in scope. . . .

In its opinion, the Federal Circuit concluded that the term 'sputter-deposited dielectric' must be narrowly interpreted consistently in all claims. To reach this conclusion, the Court ignored the differences between claim 14's predecessor and the abandoned claim 4. This rule would be appropriate to apply if the term 'sputter-deposited dielectric' was defined, in the specification or through arguments to the PTO, as an isolated, free-standing term. However, such is not the case here: petitioner used at least considerably different terms—'sputter-deposited dielectric' and 'sputter-deposited inorganic metal oxide, compound or salt dielectric'—in its patent claims to convey two different scopes of invention. Thus, the rule relied upon by the Federal Circuit is inapplicable here." (emphasis in original) (footnotes and citations omitted) Southwall's Petition for Writ of *Certiorari* (hereinafter "SWC") at 22.

Circuit, to give the *same* meaning to the term as had been given to the term by Southwall during prosecution of its patent before the U.S. Patent Office. The Federal Circuit correctly affirmed the decision of the District Court that there was no genuine issue of material fact that Cardinal's accused products lacked an element of the asserted claims in view of the unequivocal definition of "sputter-deposited" given to the Patent Office by Southwall.[2]

The Federal Circuit considered and expressly rejected Southwall's argument in stating that

> [w]hether the material of the layer was described as a "metal oxide, compound or salt" or as a "dielec-

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[2] Southwall *argues* that "sputter-deposited dielectric" cannot be interpreted as it was by the Federal Circuit because Southwall presented evidence in the form of affidavit testimony by its two experts that persons of ordinary skill in the art would construe the expression to include that which was excluded by the Federal Circuit. Southwall then argues that this conflict with the prosecution history creates a genuine issue of fact making summary judgment inappropriate. The Federal Circuit properly rejected this argument on the grounds that:

> [n]either [expert] testified as to how one skilled in the art would interpret the term "sputter-deposited." . . . [Thus,] [t]his testimony provides only *conclusory legal opinions* as to whether Cardinal's [material] is "sputter-deposited" *rather than evidence* of how that term is commonly used and understood in the art. (emphasis added)

SWC at 14a.

Contrary to Southwall's arguments otherwise, conclusory legal opinions do not provide any evidence in support of Southwall's case. *SRI International v. Matsushita Electric Corp. of America*, 775 F.2d 1107, 1116 (Fed. Cir. 1985). By showing that the evidence presented by Southwall was insufficient, as a matter of law, to support an element of the non-moving party's (Southwall) case, Cardinal has shown that no reasonable jury could return a verdict for Southwall. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248 (1986); *Celotex Corp. v. Catrett*, 477 U.S. 317, 325 (1986).

> tric" was irrelevant to the arguments Southwall made. They centered on its definition of "***sputter-deposited***" as describing a one-step reactive sputtering process rather than a two-step process. Therefore, we conclude that this substitution of phraseology did not affect the subject matter surrendered by Southwall in distinguishing the Franz reference. (emphasis added)

SWC at 29a.

The Federal Circuit Correctly Concluded That There Was No Genuine Issue Of Fact Regarding The Meaning Of "Sputter-Deposited."

The Federal Circuit, applying nothing more than time honored principles of patent law, found that the Patent Office history of the Southwall patent precluded a finding of infringement, both literally and under the doctrine of equivalents.

The determinative issue in the Federal Circuit's finding of non-infringement, however, was ***not*** the meaning of "dielectric" as asserted by Southwall but, rather, the meaning of "sputter-deposited" independently of whether it was used to modify the term "dielectric" or the term "inorganic metal oxide, compound or salt dielectric." Any distinction between "inorganic metal oxide, compound or salt dielectric" and "dielectric" was wholly immaterial to the Federal Circuit's decision. As noted by the Federal Circuit

> [e]arlier versions of some original '745 claims also used the narrower limitation "inorganic metal oxide, compound or salt" rather than "dielectric," which was used later. Although Southwall attempts to make much of this difference, it does not affect our analysis because in both instances the key phrase the

> meaning of which is at issue, "***sputter-deposited***," is used in exactly the same manner, to modify the general class of dielectric materials as the list of specific dielectric materials. The arguments regarding the "***sputter-deposited*** inorganic oxide, compound or salt" made during prosecution are thus relevant to our interpretation of "***sputter-deposited*** dielectric" for purposes of literal infringement as well as to the application of prosecution history estoppel to limit the range of equivalents accorded that term. (emphasis added)

SWC at 11a, fn. 7.

In discussing the file history of the patent-in-suit, the Federal Circuit emphatically stated that

> Southwall's analysis contains several flaws. First, whether the material of the layer was described as a "metal oxide, compound or salt" or as a "dielectric" was irrelevant to the arguments Southwall made. They centered on its definition of "***sputter-deposited***" as describing a one-step reactive sputtering process rather than a two-step process. Therefore, we conclude that this substitution of phraseology did not affect the subject matter surrendered by Southwall in distinguishing the Franz reference. (emphasis added)

SWC at 29a.

This surrender occurred in the patent applicant's response to an Office Action dated July 8, 1988, in which the Examiner rejected all pending claims over a reference's (Franz) disclosure of a "metal oxide layer . . . sputter deposited as a metal and then oxidized. . . ." According to the Examiner

> [i] t is unclear whether the "metal-oxide is sputter deposited" limitation is meant to encompass the

> situtation where the metal oxide is [s]putter deposited as a metal and later oxidized. Until clarification, the examiner most (*sic*) interpret the claims broadly.[3]

SWC at 107a.

The patent applicant responded by filing an amendment on August 19, 1988. The patent applicant distinguished the Franz reference by unequivocally limiting the definition of "sputter-deposited" to exclude a two-step process such as the one disclosed by Franz. According to the applicant

> [i]t is believed that the claims as last presented distinguished patentably over the Franz and Yatabe disclosure but to provide yet additional clear bases for distinction the claims have been amended to specify that the dielectric layer is laid down as a sputter-deposited inorganic metal oxide, compound or salt. As pointed out in the specification such layers can be laid down directly by reactive sputtering processes in which the metal is sputtered off of a metal target and directly converted to the oxide, compound or salt by the presence of a suitable gaseous reagent.

SWC at 115a.

In light of the Examiner's request for clarification with respect to the meaning of "sputter-deposited" (***not*** "sputtered-deposited dielectric") and given the disclosure

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[3]There was no "metal oxide is sputter deposited" limitation in any of the patent claims at the time of the Examiner's statements. However, the patent specification defines "dielectrics" as "inorganic oxides." Because it is also true that "dielectric" and "oxide" are considered to be interchangeable terms, it is apparent that the "metal oxide" language of the Examiner should be read as "dielectric." This is clearly acknowledged by Southwall. SWC at 8.

of Franz, the only ***reasonable*** interpretation of this statement is that "sputter-deposited" refers solely to a single step process for producing a layer of material. This is true regardless of whether the layer of material is broadly defined as a "dielectric" or more narrowly defined as an "inorganic metal oxide, compound or salt dielectric" (assuming an actual difference between the two exists).

Once the meaning of "sputter-deposited" was definitively established with respect to any one claim, its meaning was likewise definitively established with respect to every other claim in which it appeared. To paraphrase Southwall's very own statement, this rule is appropriate to apply because the term "sputter-deposited" was defined, in the specification[4] and through arguments to the U.S. Patent Office, as an isolated, free-standing term. Because the applicant had disavowed during the prosecution of the patent a definition for "***sputter-deposited***" dielectric as a material laid down as a something other than a dielectric, which material was subsequently converted to a dielectric, the Federal Circuit held that Cardinal ***could not*** literally infringe the asserted claims as a matter of law. The Federal Circuit further held that essentially the same arguments precluded a finding of infringement under the doctrine of equivalents.

Despite its broad statements with respect to tracing claim lineage in general,[5] the narrow grounds on which

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[4] According to the specification "'sputter deposit' or 'sputter deposited' refers to the *process of the* (sic) product of the process in which a layer of material is laid down by the use of a magnetron-sputterer."

[5] The Federal Circuit stated: "Given the metamorphosis that claims often go through during prosecution, it is often impossible

[footnote continued]

the Federal Circuit actually rested its decision was the fact that because the ***identical*** term was used in different claims, it had to be given the ***identical*** definition. This is not a case where different terms were used in different claims with unrelated lineages. Thus, the question which Southwall seeks to present, specifically, whether a court must, as a matter of law, arduously trace the lineage of a patent claim to assure that its interpretation is affected only by the portion of the Patent Office history which pertains to that claim, is not one actually presented by this case.

II.

THE DECISION REACHED BELOW IS NOT IN CONFLICT WITH DECISIONS OF THIS COURT.

A. The Federal Circuit Properly Considered The Claims As Separate Entities.

To support its petition, Southwall asserts:

(1) that the patent statute inherently contemplates separate consideration of the claims such that each claim is to be given separate meaning and effect; and

(2) that each claim defines a separate invention and, thus, must be examined on its own merits, apart from other claims, even in the same patent.

These arguments are of no avail here. The fact that each ***claim*** must be given separate meaning and effect

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to trace the lineage of the finally allowed claims to decide which arguments pertained to which claims. Therefore, that Southwall might have made arguments distinguishing Franz with regard to versions of the claims not now at issue does not avoid those arguments limiting later or different versions of the claims." SWC at 30a.

certainly does not limit a court to tracing only that claim's lineage in order to interpret a term of the claim. Apparently, Southwall has erroneously equated the scope of the ***claim*** as a whole with the scope of a particular ***term or phrase*** within a claim. It has long been recognized that (1) to properly interpret a claim term, the Court must look to the specification, ***other claims***, and ***the Patent Office history***, *Atlantic Thermoplastics Co., Inc. v. Faytex Corp.*, 970 F.2d 834, 837 (Fed. Cir. 1992), and (2) once a term or phrase is properly interpreted in light of all three of the above, that definition must be consistently applied to that term or phrase wherever it may appear in the patent. *Fonar Corp. v. Johnson & Johnson*, 821 F.2d 627, 632 (Fed. Cir. 1987), *cert. denied*, 484 U.S. 1027 (1988).

Southwall uses the same faulty reasoning when it recites the general rule that each ***claim*** defines a separate invention. To say that each ***claim*** defines a separate invention, however, is not to say that the same word used in different claims can be given different meanings. If the Court were to adopt Southwall's arguments, the same word used in different claims could be given different meanings. Such would be contrary to long-established precedent and common sense. *See Fonar Corp.*, 821 F.2d at 632.

B. This Court's Precedents Do Not Require Tracing Claim Lineage.

Southwall also asserts that the decision of the Federal Circuit violates precedents of this Court.[6] To make its

[6]This Court has granted a Petition for a Writ of *Certiorari* to the United States Court of Appeals for the Federal Circuit with respect to the Federal Circuit's *en banc* opinion in *Markman, Markman, Herbert and Positek, Inc. v. Westview Instruments, Inc. and*

[footnote continued]

case, Southwall has blatantly mischaracterized this Court's precedents. The cases cited by Southwall do not support its proposition that, as a matter of law, tracing of a claim's lineage is necessary to the proper interpretation of a claim.

Southwall states the familiar proposition that a patentee may not reclaim by interpretation that which was given up to obtain the patent. Southwall then cites a number of cases, stressing that in each the claim being asserted was examined as compared to other claims previously rejected, disingenuously concluding that such a comparison is a "fundamental application of tracing the lineage of the asserted claim."

Surprisingly, ***not even one*** of the cases cited by Southwall ever mentions the ***necessity*** of tracing an asserted claim's lineage in order to reach a proper interpretation. In fact, a majority of the cited cases do no more than merely recite the general rule that the patentee cannot recapture in litigation that which it abandoned in prosecution. *Schriber-Schroth Co. v. Cleveland Trust Co.*, 311 U.S. 211, 220-221 (1940). They do not trace the lineage of even a single claim.[7] At most, they refer to previously

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Althon Enterprises, Inc., 1995 U.S. LEXIS 5221 (September 27, 1995). However, even if this Court reverses *Markman* and holds that claim construction is not strictly a matter of law for the courts, it would not alter the outcome of this case. This case was decided on a motion for summary judgment before *Markman* because there was no genuine issue of material fact. Consequently, the outcome of the *Markman* appeal is immaterial to the Court's resolution of this case.

[7] *See, e.g., Hubbell v. United States*, 179 U.S. 77, 80 (1900) (In discussing the scope of the claims in light of that which was surrendered during prosecution, the Court simply noted that "[a]n examination of the history of the applicant's claim, as disclosed in the file wrapper and contents, shows that, in order to get his patent, he was compelled to accept one with a narrower claim than that contained in his original application. . . .")

canceled claims by number when determining the scope of the allegedly infringed claim.[8] To say that these cases represent a "fundamental application" of tracing a claim's lineage is misleading.

Southwall further asserts that this Court's precedents include tracing claim lineage where an asserted claim is broader than a narrower rejected claim related to the asserted claim. According to Southwall

> [t]he more typical case has been where the claim being asserted is narrower than broadened claims which were rejected. The present case presents the inverse situation, where the asserted claim is broader than a narrower claim which was rejected.

SWC at 24.

Again Southwall has misinterpreted the Federal Circuit's decision, the District Court's decision and the history of the Southwall patent by focusing on irrelevant differences in meaning between "dielectric" and "inorganic metal oxide, compound or salt dielectric" rather than on the meaning of "sputter-deposited." As originally interpreted by the Examiner, "sputter-deposited" encompassed both reactive (or one-step) sputter-depositing and the two-step method taught by Franz. In overcoming this rejection, the patent applicant ***narrowed*** the meaning of "sputter-deposited" to exclude the two-step method. Thus, the present case is a classic example of "the more

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[8] *Hubbell*, 179 U.S. at 81-82 ("The claims made in the application were as follows: . . . The examiners rejected these claims on reference to prior patents. Thereupon the claimant, having amended his specification as above, substituted for the three claims above copied the following [claim]. The examiners held . . . that a specific and well defined claim might be allowed, but not the amended claim. . . . The claimant thereupon withdrew the above amended claim and substituted [an allowable claim].")

typical case" in which the asserted claim is narrower than broadened claims that were rejected.

Nonetheless, Southwall cites *Smith v. Snow*, 294 U.S. 1 (1935), as an illustrative case in which early narrow claims were rejected but had no bearing on the assertion of later broader claims. In summarizing *Smith*, Southwall states

> [i]n interpreting the broad claim being asserted, claim 1, the Court performed an ***elaborate*** tracing of this claim's evolution:
>
> > The history of Smith's application in the Patent Office is a long one. Four groups of method claims were successively presented to the Patent Office, and three were successively rejected. The fourth group ultimately matured into claims 1, 2 and 3 of the patent. . . . It is an illuminating fact that the entire written argument filed in support of claim 1, as it was finally presented to the Patent Office and allowed, makes no reference to [various features found in the narrower claims]. . . . We find nothing in the file wrapper to suggest that any addition was made to claim 1 to restrict the patent to any particular order of arrangement of the eggs, . . . and nothing to estop the patentee from asserting that the claim is not restricted by such features. [citations omitted] It is of no moment that in the course of the proceedings in the Patent Office the rejection of narrow claims was followed by the allowance of broader claim 1.

Id. Thus, the Court undertook the effort to trace the lineage of claim 1 to assure that its lineage did not include other limitations that would exclude the accused incubator from infringement. As a matter of law, this tracing was integral to the proper interpretation of the asserted claim. *See also, Weber Electric Co. v. E.H. Freeman Electric*

> *Co.*, 256 U.S. 668 (1921); *Phoenix Caster Co. v. Spiegel*, 133 U.S. 360 (1890). (emphasis added)

SWC at 25-26.

A review of *Smith* reveals that once again Southwall has misrepresented this Court's precedent. In discussing the file wrapper in *Smith*, this Court stated (in full) that

> [t]he history of Smith's application in the Patent Office is a long one. Four groups of method claims were successively presented to the Patent Office, and three were successively rejected. The fourth group ultimately matured into claims 1, 2 and 3 of the patent. ***It suffices to say that claims 1 and 25 of the first group claimed broadly, "The method of hatching eggs by arranging the eggs in a column and applying heated air forced about the eggs, the heated air being adapted to the eggs in various stages of incubation," and "The method of hatching eggs by arranging the eggs in a column one above the other and forcing heated air through said column." In due course the broad claims thus asserted were modified and narrowed by the inclusion of new elements, until they appeared in the form of claim 1 of the patent. But, as we have seen, none of these additions involve any particular order of arrangement of the eggs or any particular direction or control of the air current, except that the current is to be "of sufficient velocity to circulate, diffuse and maintain the air throughout the chamber at substantially the same temperature."*** (emphasized text omitted by Southwall)

Smith, 294 U.S. at 15.

Contrary to Southwall's representations, *Smith* is not a case in which this Court performed "an ***elaborate*** tracing" of the asserted claim's evolution. *Smith* is also not a case in which early narrow claims were rejected but

later broader, related claims were allowed, and *Smith* is not a case in which only claims in the asserted claim's lineage were reviewed.

This Court's precedents simply do not mandate tracing an asserted claim's lineage to properly interpret the language used therein. Because the Federal Circuit's decision does not conflict with the precedents of this Court, Southwall's Petition for Writ of *Certiorari* should be denied.

CONCLUSION

This is a simple case of claim construction in which the Federal Circuit properly interpreted a claim term (***"sputter-deposited"***) in light of the specification, other claims, and the Patent Office history and found no possibility of infringement as a matter of law. The Federal Circuit did not construe the term on the basis of arguments made with respect to a different term. Southwall's arguments to the contrary contort the Patent Office history by focusing on the meaning of "dielectric" despite the clear thrust of the Examiner's rejection with regard to "sputter-deposited." Thus, the question presented by Southwall is not one presented by this case.

Furthermore, the Federal Circuit's decision does not conflict with this Court's precedents.

The Petition for a Writ of *Certiorari* should be denied.

Respectfully submitted,

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